

REMARKS

The Applicant respectfully submits that the withdrawn claims, specifically claims 4, 5, 9-16, 18-20, 22 and 23 having been cancelled and claims 24-25 having been added, that 11 claims, specifically claims 1-3, 6-8, 17, 21 and 24-25 are properly under consideration in the present application, claims 1 and 21.

The Applicant notes with appreciation that the Examiner has indicated that all of the certified copies necessary to support the priority claim under 35 U.S.C. § 119 have been received in this National Stage application.

Rejection under 35 U.S.C. § 101

Claim 21 has been rejected under 35 U.S.C. § 101 because the claim recites a “use” without including any steps involved in the process.

As reflected in the amendments above, the Applicant has amended claim 21 to recite a method of treating and preventing infectious processes in humans, animals, and plants comprising administering an effective amount of at least one anti-infectiously active compound which inhibits the 2-C-methylerythrose-4-metabolic pathway and at least one lipid metabolism inhibitor, wherein the anti-infectiously active compound and the at least one lipid metabolism inhibitor are not identical.

The Applicant respectfully submits that support for this amendment is found in original claim 21 and that this claim recites a proper method claim. Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw this rejection.

Rejection under 35 U.S.C. § 112, second paragraph

Claims 3, 4, 6, and 21 have been rejected under 35 U.S.C. § 112, second paragraph, as indefinite.

The Applicant respectfully notes that claim 4 has been cancelled and respectfully submits that the amendments to claims 3, 6 and 21 reflected above are sufficient to render the claims sufficiently definite. In particular, with respect to claims 3 and 6, the exemplary compound originally recited in connection with each of the derivatives has been removed and the claims recast in more traditional Markush format. With respect to claim 21, as noted above, the claim has been amended to recite a method having a step.

The Applicant respectfully requests, therefore, that this rejection be withdrawn.

Rejection under 35 U.S.C. § 103(a)

Claims 1-3, 6-8, 17 and 21 stand rejected under 35 U.S.C. § 103(a) as unpatentable over U. Sheffield (PCT WO 97/43437) ("Sheffield"), Teijin Ltd. (JP 61-106504) ("Teijin") and Kamuro et al., U.S. Patent No. 4,846,872 ("Kamuro") The Applicant respectfully traverses this rejection.

The Applicant initially notes that claims 1-3, 6-8 and 21, as amended above, are not directed to herbicidal compositions, but rather to combinations of separate distinct anti-infectiously active and lipid metabolism inhibitor compounds. The Applicant respectfully contends that references directed to particular herbicidal compositions and/or combinations of such compositions would not be understood by one of ordinary skill in the art as being useful for treating infections.

The Applicant respectfully notes that the disclosure provided by Sheffield is focused on the "treatment of various diseases and disorders of bone metabolism in the screening, isolation and synthesis and the valuation of osteoactive drugs as hypolipidaemic and as anti-cancer

agents” The Applicants respectfully submit that Sheffield’s generic statements on pages 17 and 27 regarding the usefulness of isopentenyl pyrophosphate isomerase (IPI) inhibitors and/or prenyl transferase inhibitors as herbicides and fungicides is so generally unrelated to the disclosure provided on the remaining 50 pages of the disclosure that one of ordinary skill in the art would have been led to and would not have relied on Sheffield’s disclosure in connection with investigations unrelated to the recited medicinal uses.

The Applicant further contends that the Action has not identified motivation within the disclosures of Sheffield, Tejin and/or Kamuro for making a composition having utility other than as an herbicide. The Applicant also respectfully contends that the Action identifies no disclosure in Sheffield that would suggest to one of ordinary skill in the art that the addition of known herbicides would be advantageous to the function or utility of medicants directed to bone disorders and disorders characterized by uncontrolled cell proliferation, *e.g.*, cancer.

The Applicant notes that a *prima facie* case of obviousness requires some suggestion or motivation available to one of ordinary skill in the art to modify or combine the reference(s) in the manner suggests, the proposed modification or combination must have a reasonable expectation of success, and the prior art reference(s) must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). The mere fact that the references can be combined or modified in the manner suggested, absent some suggestion that such a combination or modification would be desirable, is insufficient to render the claimed invention obvious. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990).

The Applicant respectfully requests, therefore, that this rejection be withdrawn.

CONCLUSION

In view of the above remarks and amendments, the Applicants respectfully submit that each of the pending objections and rejections have been addressed and overcome, leaving the present application in condition for allowance. A notice to that effect is respectfully requested.


If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to contact the undersigned.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge any underpayment or non-payment of any fees required under 37 C.F.R. §§ 1.16 or 1.17, or credit any overpayment of such fees, to Deposit Account No. 08-0750, including, in particular, extension of time fees.

Very truly yours,

HARNESS, DICKEY & PIERCE, P.L.C.

By:


Gregory P. Brummett
Reg. No. 41,646

P.O. Box 8910
Reston, VA 20195
(703) 668-8000

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